

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested in light of the remarks which follow.

I. Claim Amendments

By the foregoing amendments to the claims, claims 1, 3, 8, and 12-18 have been amended, and claims 2 and 19 have been cancelled.

In particular, claim 1 has been amended to clarify that the recited feed comprises two components, and that the component "fish meal, soybean meal or a mixture thereof" is different from the effective component. This amendment is supported at least at pages 109-113 of the specification (Example 2).

Claim 1 has been further amended to recite that the effective component is "a compound selected from the group consisting of maslinic acid, physiologically acceptable salts thereof and derivatives thereof," as supported at least by original claim 2. Corresponding amendments have also been made to claims 12-18.

In addition, claim 8 has been amended to depend from claim 7 rather than from claim 5.

The amendments to the claims, including cancellation of claims, have been made without prejudice or disclaimer to any subject matter recited or canceled herein. Applicants reserve the right to file one or more continuation and/or divisional applications directed to any canceled subject matter. No new matter has been added, and entry of the foregoing amendments to the above-identified application are respectfully requested.

II. Response to Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-10 and 19 have been rejected under 35 U.S.C. § 112, second paragraph, as purportedly indefinite for the following reasons.

A. The Examiner has stated that it is unclear whether the fish meal, soybean meal, or a mixture thereof is included in the Markush group of claim 1.

As noted above, claim 1 has been amended to clarify that the fish meal, soybean meal, or a mixture thereof defines a second component of the recited feed and is not included in the Markush group defining the first component.

B. The Examiner has stated that one cannot determine if claim 19 is reciting a method or a composition.

Claim 19 has been canceled, rendering this aspect of the indefiniteness rejection moot.

C. The Examiner has stated that there is insufficient antecedent basis for the limitation "the water-containing alcohol" in claim 8.

As noted above, claim 8 has been amended to depend from claim 7 rather than from claim 5, thus providing sufficient antecedent basis for "the water-containing alcohol."

In view of the above, Applicants respectfully request reconsideration and withdrawal of this rejection.

III. Response to Claim Rejections Under 35 U.S.C. § 102

A. Claims 1-2, 9 and 10 have been rejected under 35 U.S.C. § 102(b) as purportedly anticipated by Uchino et al. (JP 10-265328).

B. Claim 12 has been rejected under 35 U.S.C. § 102(b) as purportedly anticipated by Glinski et al. (U.S. Patent Publication No. 2001/0018459).

These rejections are respectfully traversed.

It is well established that for prior art to be anticipatory, every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Applicants submit that Uchino et al. and Glinski et al. both fail to satisfy this requirement, for at least the following reasons.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, the claims have been amended as noted above. In particular, the claims have been amended to recite compositions comprising maslinic acid. However, in contrast to the present claims, the cited references do not teach or even suggest compositions comprising maslinic acid.

Because neither Uchino et al. nor Glinski et al. disclose each and every limitation recited in the amended claims, the claims are not anticipated by either of the cited references.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections.

IV. Response to Claim Rejections Under 35 U.S.C. § 103

A. Claims 3-8 have been rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Uchino et al. in view of Lopez de Hierro (U. S. Patent No. 6,037,492).

B. Claim 13 has been rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Glinski et al. in view of Lopez de Hierro.

C. Claim 14 has been rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Glinski et al. in view of Takagi et al. (U. S. Patent No. 4,571,256).

D. Claims 15-18 have been rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Uchino et al. and Glinski et al. in view of Lopez de Hierro.

These rejections are respectfully traversed.

With regard to claims 3-8, Applicants note that in order to expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, independent claim 1 has been amended to recite the subject matter of claim 2. Claim 2 has not been included in the obviousness rejections. Furthermore, claims 3-8 all depend ultimately from claim 1. Accordingly, this amendment should be sufficient to overcome the obviousness rejection with regard to claims 3-8.

The present inventors have surprisingly discovered that maslinic acid inhibits the production of melanin (see, e.g., Example 1 of the present specification). With regard to claims 13 and 14, Applicants submit that for the reasons set forth above, neither Uchino et al. nor Glinsky et al. teach a composition comprising maslinic acid. In addition, neither Uchino et al. nor Glinsky et al. teach or even suggest that maslinic acid has melanin production-inhibitory activity. Furthermore, the additional references cited by the Examiner do not remedy the serious deficiencies of Uchino et al. and Glinsky et al. In particular, although Lopez de Hierro discloses a method of producing maslinic acid from olive, this reference does not teach or suggest a fertilizer comprising maslinic acid, nor that maslinic acid would inhibit melanin production in plants. Similarly, Takagi et al. discloses a fertilizer, but the reference fertilizer does not comprise maslinic acid as an effective component. Thus, a person of ordinary skill in the art would not have been motivated to use maslinic acid in a fertilizer as recited in claim 13 or in claim 14 with any reasonable expectation of success.

With regard to claims 15-18, as discussed above none of the cited references teach or suggest an agent or composition comprising maslinic acid. Furthermore, none of the references, taken alone or together, teach or suggest that maslinic acid has melanin production-inhibitory activity. Thus, a person of ordinary skill in the art would not have been

motivated to use maslinic acid in a melanin-production inhibitory agent or blackening/browning inhibitory composition as recited in claims 15-18 with any reasonable expectation of success.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections.

CONCLUSION

From the foregoing, favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions related to this response, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney at the below-listed telephone number concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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